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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,423	09/28/2001	Colin C. Felton	077650-0107	6383
23524	7590	07/30/2004	EXAMINER	
FOLEY & LARDNER 150 EAST GILMAN STREET P.O. BOX 1497 MADISON, WI 53701-1497			CHAPMAN, JEANETTE E	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/966,423	FELTON, COLIN C.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chapman E Jeanette	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 April 2004.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5, 7-10 and 20-31 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 21 is/are allowed.

6) Claim(s) 1-5, 7-10, 20 and 22-30 is/are rejected.

7) Claim(s) 31 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4/15/03

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if claim 29 is an article or method claim as claim 29 depends on claim 1 which is an article claim; claim 29 is drafted as if claim 1 is a method claim. It is unclear as to which class of inventions is being recited. Claim 29 has not been amended as stated in the April 2004 amendment.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-10, 20 and 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston (2096968) in view of Wang (5922379). Johnston discloses an homogenous construction panel in figure V having upper and lower portions. The lower portion comprises or ***provides the appearance of*** a plurality of vertically extending member which are of an appropriate shape and size to provide the

appearance of a shingle, shake or tile. The panels are shown to have uniform and non uniform widths and lengths; see figures 1-2 and figures 3-4 respectively.

The panel has two to seven vertically extending members.

The size of the panels has been considered a matter of choice depending on the size of the roof to be covered; one of ordinary skill in the art would have appreciated the proper size and would have selected that suitable to cover/form the roof.

The material of construction has been deemed a matter of choice. One of ordinary skill in the art would have appreciated all of the materials available for use and would have selected any one which fulfilled the intended purpose of his panel. Nevertheless, Wang teaches a thermoplastic material having a combination of a natural plant fiber and synthetic polymer; column 1, lines 40-47. The fiber is selected from wood and other materials; see claim 38.

The density of the materials has been considered a matter of choice which is made according to the intended function of the device. Because the recited materials are shown to be disclosed by the prior art and the weight compositions close to those of the recited compositions, the construction panel of Johnston made of the material of Wang would also have an impact rating of class 3 or 4 as recited in claim 23 and class a/b/c fire classification as in claim 24.

The particular composition or proportion by weight of each material has been further considered a matter of choice; one of ordinary skill in the art would have appreciated the choice and would have selected the proportion according to the intended purpose and function of the device.

The plurality of members are of non-uniform widths and lengths and lower edges.

The lower portion of the panel comprises a textured surface. The textured surface may replicate wood, clay, ceramic, slate tile and combinations thereof; see column 1, the first 2 paragraphs. The fiber is of a mineral and hence of a natural plant.

Claim 29; As far as understood it is clear that claim 1 is an article claim but unclear as to what class of invention is being recited with claim 29. Hence claim 29 is treated as an article claim. The examiner has considered only the article limitations in the claim. After an amendment, and it is clear that claim 29 is a method claim the claims will be subject to a restriction requirement

Claim 21 is allowable over the prior art of record.

### ***Allowable Subject Matter***

Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed April 19 ,2004 have been fully considered but they are not persuasive. Applicant argues claim 29 should be allowable as it depends on an allowable claim. Claim 29 does not depend on an allowable claim; claim 29 depends on claim 1 which is rejected

Applicant argues that the prior art does not provide a prima facie case of obviousness. The claimed limitations shown by Johnston and Wang have been clearly

shown. Obviousness rational has been given for limitations that concern size, shape and measurements. Allowability is not granted because a thermoplastic material may come in a different forms while other limitations are met. Applicant argues that the prior art does not disclose of a synthetic polymer. In column 1, lines 40-47, Wang discloses that natural and synthetic polymers are known. It is obvious that the function of the polymers are known and the use of such polymers are provided accordingly. See column 1, line 50-column 20 which discuss the function of both natural and synthetic polymers. Their interchangeable use is even discussed. Applicant's whole argument is base mostly on how the prior art fails to disclose this synthetic polymer and how such is not known . See patent 4592795.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E Jeanette whose telephone number is 703-308-1310. The examiner can normally be reached on Mon.-Fri, 8:30-6:00, every other fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Friedman Carl can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 305-7687 for regular communications and 305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

jec  
July 28, 2004



Jeanette Chapman  
Primary Examiner